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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,325	10/19/2006	Peter Titz	065517.00076	9676

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EXAMINER

STRIMBU, GREGORY J

ART UNIT	PAPER NUMBER
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3634

MAIL DATE	DELIVERY MODE
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10/13/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/530,325	Applicant(s) TITZ, PETER	
	Examiner Gregory J. Strimbu	Art Unit 3634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-20 and 22-38 is/are pending in the application.
- 4a) Of the above claim(s) 7-9,15,16,24-26,32,33 and 35-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,10-14,17-20,22,23,27-31,34 and 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 August 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Upon further review of the application the restriction requirement of December 30, 2009 was improper is hereby withdrawn. Thus, the applicant's response of February 26, 2010 is moot. Additionally, the restriction requirement of January 9, 2009 is flawed. Species 1 only includes figures 3-8 and does not include figure 12. Since the applicant has elected the embodiment of species 1 in the response of March 4, 2009 and prosecution of species 1 has already commenced, species 1 is the only species which currently under examination.

Claims 7-9, 15, 16, 24-26, 32, 33 and 35-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 4, 2009.

Drawings

The drawing correction filed August 4, 2010 has been approved.

Specification

The disclosure is objected to because of the following informalities: recitations such as "A-A" on lines 12 and 14 of page 4 should be changed to --4-4-- or --IV-IV-- to agree with the drawing changes.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 1-3, 5, 6, 10-14, 17-20, 22, 23, 27-31, 34 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as "or" on line 1 of claim 1 render the claims indefinite because it is unclear what the applicant is attempting to set forth. It appears that the invention comprises the combination of a sealing strip, a trimming strip and a guiding strip rather than only one of the above. Additionally, the first line of claim 1 sets forth that the invention is one of a sealing, trimming or guiding strip rather than setting forth that the invention performs one of the functions of sealing, trimming or guiding. Recitations such as "at the interior side of the window pane" on lines 13-14 of claim 1 render the claims indefinite because it is unclear what spatial relationship the applicant is attempting to set forth. Note that the window pane or a vehicle is not being positively claimed. How is one supposed to know which side is the interior side of a window pane when only looking at the strip. Recitations such as "so as to clamp the window pane" on line 2 of claim 12 render the claims indefinite because it is unclear whether or not the applicant is positively reciting the window pane. Note that claim 1 implies that the window pane is not being positively recited while line 2 of claim 12 implies that the window pane is being positively recited. Claim 38 is rejected because it is unclear what the applicant is attempting to set forth. Claim 1 sets forth that a first window pane receiving surface at the interior side of the window pane, a second window pane receiving surface at the exterior side of the window pane, and an opposite facing

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surface facing opposite to the second surface and being visible from the exterior of the vehicle. If the oppositely facing surface is at the interior side of the window pane, it is unclear how the oppositely facing surface can be visible from the exterior of the vehicle.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 10-13 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Backes et al. (US 6082048). Backes et al. discloses a sealing, trimming or guiding strip for a window frame of a vehicle, said strip being disposed to selectively contact a window pane 76 having an interior side 76A and an exterior side 76B, said strip comprising:

a length of extruded material 54 forming part of the strip,

a portion of the extruded material along only part of the length of the extruded material having been removed and replaced with molded material 40 which is molded onto and thereby connected to the extruded material,

the extruded material including a channel 58 for receiving a flange of the window frame and a rigid reinforcing carrier 64 embedded within the extruded material in a region corresponding to the channel,

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the channel remaining as part of the strip after removal of said portion of the extruded material,

the molded material 40 forming a first window pane receiving surface 78 at the interior side of the window pane,

the extruded material 54 extending from the channel and having a second window pane receiving surface 80 at the exterior side of the window pane and a generally oppositely facing surface (not numbered, but comprising the surface at the end of the lead line of reference character 54 as shown in figure 3) facing opposite the second window pane receiving surface and directly visible from the exterior of the vehicle, this extended extruded material also remaining as part of the strip after removal of said portion of the extruded material; and

the molded material including at least one integral formation 42 for securing the molded material to the window frame;

wherein the molded material is extended to form a closed loop (not numbered, but shown surrounding the opening 8) (claim 2);

wherein the length of extruded material beyond said portion thereof extends from the closed loop (claim 3);

wherein the extruded material 54 includes a plurality of integral formations 66 for securing the extruded part to the window frame (claim 10);

further comprising an elongate rigid member 44 into which a portion of the strip is fitted (claim 11);

wherein the molded material 40 is fitted into the rigid member 44 so as to clamp the window pane 76 fitted in said molded material (claim 12);

wherein the rigid member 44 also accommodates a further length of extruded material having a window pane receiving channel (claim 13);

wherein the extruded material includes a limb (not numbered, but comprising the portion of the channel 58 having elements 60 and 62) forming at least a part of a window pane receiving channel, a portion of the window pane receiving channel being removed by removal of said portion of the extruded material (claim 17).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Backes et al. as applied to claims 1-3, 10-13 and 17 above and further in view of Carvalho et al. (US 6817651). Carvalho et al. discloses a seal strip 160 which is fitted into an elongate rigid member 200, wherein the rigid member is substantially H-shaped as shown in figure 9.

It would have been obvious to one of ordinary skill in the art to provide the rigid member 9 of Backes et al. with an H-shaped configuration, as taught by Carvalho et al., to more securely mount the seal strip to the window frame.

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Claims 1, 10-13, 17 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morita (US 5209019) in view of Nozaki et al. (US 5269101). Morita discloses a sealing, trimming or guiding strip 1 for a window frame 91 of a vehicle, said strip being disposed to selectively contact a window pane 92 having an interior side and an exterior side, said strip comprising:

- a length of extruded material forming part of the strip 1 as set forth in col. 3, ln. 35-37,

- the extruded material including a channel 11 for receiving the flange 911 of the window frame and a rigid reinforcing carrier 2 embedded within the extruded material in a region corresponding to the channel,

- the extruded material extending from the channel and having a second window pane receiving surface (labeled below) at the exterior side of the window pane and a generally oppositely facing surface (labeled below) facing opposite the second window pane receiving surface and directly visible from the exterior of the vehicle;

- and the extruded material including at least one integral formation 126 for securing the molded material to the window pane;

- the integral formation 126 includes a plurality of integral formations (not numbered, but comprising the upper and lower ends of the formation 126) (claim 10);

- an elongate rigid member 912 (claim 11);

- the formation 126 is fitted into the rigid member (claim 12).

Morita is silent concerning removing a portion of the extruded material.

However, Nozaki et al. discloses a method of forming a seal comprising extruding a length of material (see col. 3, ln. 24-26) to form part of the strip 10;

removing a portion (see col. 3, ln. 40-42 and fig. 5) of the extruded material along part only of the length thereof, and

replacing the said portion with molded material 1C which is molded onto and thereby connected to the extruded material; wherein:

a channel 11 remains as part of the strip after removal of said portion of the extruded material,

the molded material forms a first window pane receiving surface at the interior side of the window pane.

It would have been obvious to one of ordinary skill in the art to provide Morita with a molded portion and its attendant method steps, as taught by Nozaki et al., to improve the seal quality at the corners of the window frame and to provide a more secure means for mounting the side light of the rear door to the window frame.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morita in view of Nozaki et al. as applied to claims 1, 10-13, 17 and 38 above, and further in view of Furman (US 4591203). Furman discloses a molded sealing strip 22 including an aperture 38 in the molded sealing strip 22 through which a clamping member 42 is disposed, the clamping member is attached to a window pane 20 and the window pane is secured to a window frame 12 by the clamping member passing

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through the aperture in the molded part 22 and through a further aperture 16 in the window frame.

It would have been obvious to one of ordinary skill in the art to provide Morita, as modified above, with an attachment means, as taught by Furman, to more securely attach the window pane to the window frame.

Claims 18, 27-29 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morita (US 5209019) in view of Nozaki et al. (US 5269101). Morita discloses a method of forming a sealing, trimming or guiding strip 1 for a window frame 91 comprising a flange 911 and a window pane 92 having an interior side and an exterior side, the method including:

extruding a length of material to form part of the strip 1 as set forth in col. 3, ln. 35-37,

the extruded material includes a channel 11 for receiving the flange 911 of the window frame and a rigid reinforcing carrier 2 embedded within the extruded material in a region corresponding to the channel,

the extruded material extends from the channel and has a second window pane receiving surface (labeled below) at the exterior side of the window pane and a generally oppositely facing surface (labeled below) directly visible from the exterior of the vehicle;

and the molded material includes at least one integral formation 126 for securing the molded material to the window frame;

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the integral formation 126 includes a plurality of formations (not numbered, but comprising the upper and lower ends of the formation 126) (claim 27);

an elongated rigid member 912 is provided into which a portion of the strip is fitted (claim 28);

Morita is silent concerning removing a portion of the extruded material.

However, Nozaki et al. discloses a method of forming a seal comprising extruding a length of material (see col. 3, ln. 24-26) to form part of the strip 10;

removing a portion (see col. 3, ln. 40-42 and fig. 5) of the extruded material along part only of the length thereof, and

replacing the said portion with molded material 1C which is molded onto and thereby connected to the extruded material; wherein:

a channel 11 remains as part of the strip after removal of said portion of the extruded material,

the molded material forms a first window pane receiving surface at the interior side of the window pane.

It would have been obvious to one of ordinary skill in the art to provide Morita with a molded portion and its attendant method steps, as taught by Nozaki et al., to improve the seal quality at the corners of the window frame and to provide a more secure means for mounting the side light of the rear door to the window frame.

Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morita in view of Nozaki et al. as applied to claims 18, 27-29 and 34 above, and

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further in view of Levy et al. (US 5557890). Levy et al. discloses a sealing strip 4 comprising a molded material (see col. 2, ln. 59-61) wherein the molded material comprises a closed loop as shown in figure 1 and a length of material 5 extends from the closed loop.

It would have been obvious to one of ordinary skill in the art to provide Morita, as modified above with a closed loop, as taught by Levy et al., to more securely and sealingly mount a side light to the window frame.

Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morita in view of Nozaki et al. as applied to claims 18, 27-29 and 34 above, and further in view of Furman (US 4591203). Furman discloses a molded sealing strip 22 including an aperture 38 in the molded sealing strip 22 through which a clamping member 42 passes, the clamping member is attached to a window pane 20 and the window pane is secured to a window frame 12 by the clamping member passing through the aperture in the molded part 22 and through a further aperture 16 in the window frame.

It would have been obvious to one of ordinary skill in the art to provide Morita, as modified above, with an attachment means, as taught by Furman, to more securely attach the window pane to the window frame.

Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morita in view of Nozaki et al. as applied to claims 18, 27-29 and 34 above and

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further in view of Carvalho et al. (US 6817651). Carvalho et al. discloses a seal strip 160 which is fitted into an elongate rigid member 200, wherein the rigid member is substantially H-shaped.

It would have been obvious to one of ordinary skill in the art to provide the dividing bar of Morita, as modified above, with an H-shaped configuration, as taught by Carvalho et al., to more securely mount the seal strip to the window frame.

Response to Arguments

Applicant's arguments filed August 4, 2010 have been fully considered but they are not persuasive.

The applicant argues that Backes et al. fails to anticipate the applicant's claimed invention because Backes et al. fails to disclose the removal of a portion of the extruded material and replacement of the removed material by a molded material. This is not persuasive because the applicant is claiming the product of a sealing, trimming or guiding strip. Thus, limitations directed to how the sealing, trimming or guiding strip is made have been treated as product-by-process limitations. In other words, Backes et al. does not need to disclose the method by which the applicant makes the sealing, trimming or guiding strip because the applicant is only claiming the product of the sealing, trimming or guiding strip.

The applicant's comments concerning Bonne et al. are moot in view of the withdrawal of the rejection based on Bonne et al.

In response to applicant's arguments against Morita and Nozaki et al. individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Morita discloses the integral formation 126 while Nozaki et al. discloses a molded material used to attach a seal to a frame.

With respect to the applicant's arguments that one of ordinary skill in the art would not have combined the teachings of Morita and Nozaki et al., the examiner

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respectfully disagrees. It is well known in the art to manufacture a seal from a soft material so as to provide a good seal between the moving object, i.e., the window pane, and its supporting structure, i.e., the window frame. Forming the entire seal from a soft material, however, creates the problem of sufficiently securing the seal to the supporting structure. A well known solution to this problem is to make the seal from two different types of material, a first soft material to provide good sealing characteristics and a second hard material with good strength. The combination of the teachings of Morita and Nozaki et al. would merely achieve the known solution to providing good sealing characteristics while provided good mounting characteristics.

With respect to the applicant's comments concerning a cut line, the examiner respectfully disagrees. Nozaki et al. discloses a cut line in figure 4 with a portion 1A of the extruded member remaining after the removal of the extruded material 12. It should be noted that the molded material of Nozaki et al. functions as a mount since it is used to attach the seal to the door frame via the tape 25.

With respect to the applicant's arguments concerning claims 5 and 22, the examiner respectfully disagrees. It appears that the applicant is arguing that providing Morita with the hole and pin of Furman would destroy the seal 121 of Morita. This is not persuasive because Furman teaches co-molding the pin with the molded strip 22 as set forth in column 3, lines 32-35. Thus, a co-molded pin would not interfere with the sealing functions of Morita.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 571-272-6836. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katherine Mitchell can be reached on 571-272-7069. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gregory J. Strimbu/
Primary Examiner, Art Unit 3634